

P37034

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE OFFICE OF PETITIONS**

In re Patent Application of:  
Cindy KOHANEK et al.

Application No.: 09/904,425

Confirmation No.: 1776

Filed: July 12, 2001

Art Unit: 2859

For: LINEARITY MEASURING APPARATUS FOR  
WAFER ORIENTATION FLAT

Examiner: G. Bradley Bennett

Attorney Docket No.: P37034

**DECLARATION OF NOBUYUKI HAYASHI,  
KOKI MASUDA, TOSHINOBU MIURA AND HIROYUKI HASEGAWA**

Commissioner for Patents  
U.S. Patent and Trademark Office  
Customer Service Window, Mail Stop  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Sir:

We, Nobuyuki Hayashi, Koki Masuda, Toshinobu Miura and Hiroyuki Hasegawa  
hereby declare and state as follows:

1. I am a citizen of Japan and am more than twenty-one (21) years of age;
2. For each statement made herein in reference to the pronoun "I", the statement is being made individually by each of Nobuyuki Hayashi, Koki Masuda, Toshinobu Miura and Hiroyuki Hasegawa; and each statement made by only one individual includes reference to the one individual's name, e.g., "I, Koki Masuda".

3. I am presently employed by SUMCO Corporation ("SUMCO"), and have worked for SUMCO or its predecessor companies under the general family name of Mitsubishi Materials Silicon Corporation ("MSIL"), and for the sake of simplicity, I shall refer to SUMCO and its predecessor companies in the remainder of this Declaration generally and collectively as SUMCO;

4. I, Nobuyuki Hayashi, have been involved with the prosecution of applications in the Intellectual Property Department in Production & Technology Division of SUMCO (hereinafter "SUMCO IP Department"), between the general time period of 1994 through January 31, 2002 and from 2007 until the present, and am presently General Manager of the Department;

I, Koki Masuda, have been involved with the prosecution of applications in the SUMCO IP Department, between the general time period of 1994 through most of 2005, and am presently Assistant Manager of Engineering Planning Department;

I, Toshinobu Miura, have been involved with the SUMCO IP Department, between the general time period of 2003 mainly working on patent lawsuit, and from early 2008 until the present mainly working on the prosecution of applications, and am presently Manager of the Department; and

I, Hiroyuki Hasegawa, have been involved with the prosecution of applications in SUMCO IP Department, from early 2008 until the present, and am presently Assistant Manager of the Department;

5. The General Manager of the SUMCO IP Department, Mr. Hiroyuki Takeuchi, has executed, on January 29, 2009, a Declaration of Hiroyuki Takeuchi (hereinafter "the Takeuchi Declaration", a copy of which is attached hereto and labeled Exhibit 6) in

connection with the above-identified application, which I have read and reviewed. The Takeuchi Declaration includes statements regarding the parties involved and their relationships, individuals involved with the applications, the general handling of correspondence with respect to Japanese and foreign Office Actions, and the discovery of the abandonment of the '425 application. I agree with each of the statements and I incorporate each of these statements by reference herein as if fully set forth in this Declaration.

6. One of the outside patent attorneys in Japan that is retained by the SUMCO IP Department is Mr. Masayoshi Suda at the Suda Patent Office (hereinafter "SPO"), and one of the U.S. attorneys retained by SPO to prosecute applications before the U.S. Patent and Trademark Office (hereinafter "PTO") was Mr. Jules Goldberg at the law firm of Reed Smith;

7. Among the matters entrusted over the years to Mr. Goldberg through SPO for SUMCO IP Department work was the preparation, filing, and prosecution of U.S. Application No. 09/904,425 (hereinafter "the '425 application"), filed on July 12, 2001 for inventors Cindy Kohanek and Gary Babb, entitled "Linearity Measuring Apparatus for Wafer Orientation Flat;"

8. The present assignees of the '425 application are SUMCO Corporation and the SUMCO PHOENIX Corporation ("SPX"), a SUMCO subsidiary located in the U.S. Ultimate responsibility for the prosecution of the '425 application, despite the joint ownership of SPX in the '425 application, was and remains with the SUMCO IP Department in Japan;

9. The '425 application was filed in the PTO by Mr. Goldberg at the Reed Smith law firm through the auspices of SPO, the Reed Smith law firm being considered by the SUMCO IP Department as a large New York law firm which the SUMCO IP Department could fully rely upon for prosecution of applications before the PTO;

10. With regard to office actions received from offices foreign to Japan, including the PTO, the SUMCO IP Department has observed that SPO usually translates into English our Department's Japanese comments to SPO on those actions, and then prepares and sends those English instructions to the foreign patent attorneys in light of those comments -- usually two weeks before the actual due date of a response to the office action;

11. I, Koki Masuda, had first hand knowledge as of about late on or about August 20, 2002 of the mailing of an Office Action in connection with the '425 application on July 3, 2002, and communicated with SPO on September 2, 2002 through my assistant, Ms. Nagao, regarding the Office Action providing instructions for filing a response thereto;

12. I, Koki Masuda, received further correspondence from SPO about the end of September forwarding September 20, 2002 correspondence from Mr. Goldberg;

13. I, Koki Masuda, received further correspondence from SPO on or about October 10, 2002 requesting instructions for filing a response, and provided instructions in correspondence to SPO on or about October 16, 2002, and was informed in correspondence from SPO on or about October 17, 2002 of an October 17, 2002 letter of instructions being forwarded to Mr. Goldberg;

14. Upon the forwarding instructions for filing a response by SPO to Mr. Goldberg, it was expected that without further instruction on the part of the SUMCO IP Department, the '425 application would proceed to allowance without any further input from the SUMCO IP Department;

15. On information and belief, I, Koki Masuda, received correspondence from SPO on or about October 6, 2004 from SPO regarding payment of invoices in connection with the activities of Mr. Goldberg in connection with the '425 application and, on information and belief, did not associate this invoice with substantive issues regarding the '425 application;

16. I, Koki Masuda, was responsible for the file at the time of the mailing of the Office Action on July 3, 2002 through its abandonment in January 2003, and state herewith and with first hand knowledge that there was no intent to abandon the application. In fact, to the contrary, instructions were provided from the SUMCO IP Department through SPO to Mr. Goldberg to file a response to the July 3, 2002 Office Action, the SUMCO IP Department was aware that the U.S. attorney had received the instructions for filing a response, and it was expected that no further action was needed on the part of the SUMCO IP Department until receipt of further communication from the U.S. attorney through SPO;

17. During the period of abandonment of the application, I state that having first hand knowledge of the application during the general time periods as indicated in paragraph 4 above, I did not intend for the application to be abandoned, and was not aware that the application had been abandoned until at least December 2008;

18. The SUMCO IP Department maintains an Administrative Excel Table upon receiving a new Office Action. The SUMCO IP Department does not have in place a procedure for reviewing the status of U.S. files unless a new action is forwarded and received from the U.S. law firm. In the instant situation, no further communication was received regarding a new action from Mr. Goldberg through SPO following the forwarding the July 3, 2002 Office Action, and accordingly I, and on information and belief, the SUMCO IP Department did not become aware of the abandonment of the '425 application until at least December 2008;

19. On or about December 2006, SUMCO IP Department began to adopt Virtual Private Network (VPN) in order to correspond with Japanese patent law firms including SPO. After receiving an office action, such as an office action from SPO, SUMCO IP Department instructs SPO how to respond to the office action by email along with "Remarks", and requests in the email, "If filing a response to OA before PTO, please let us know its filing date". From early 2007 until the present, the SUMCO IP Department has corresponded with SPO mostly by VPN, and filing dates have been requested to at least keep track of timely filings without unknown extensions of time.

20. In signing this Declaration, I understand that the Declaration will be filed as evidence in support of a Petition to Revive the '425 application; and

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I declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true. I further declare that these statements were made with the knowledge and understanding that willful false statements and the like so made are punishable by fine, or imprisonment or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of any U.S. patents issued from such applications.

Respectfully submitted,

Dated: 10/26/2009

Nobuyuki Hayashi  
Nobuyuki Hayashi

Dated: 10/23/2009

Koki Masuda  
Koki Masuda

Dated: \_\_\_\_\_

\_\_\_\_\_  
Toshinobu Miura

Dated: \_\_\_\_\_

\_\_\_\_\_  
Hiroyuki Hasegawa

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE OFFICE OF PETITIONS**

In re Patent Application of:  
Cindy KOHANEK et al.

Customer No.: 07278

**Application No.: 09/904,425**

Confirmation No.: 1776

Filed: July 12, 2001

Art Unit: 2859

For: LINEARITY MEASURING APPARATUS  
FOR WAFER ORIENTATION FLAT

Examiner: G. Bradley Bennett

Attorney Docket No.: 21223/0211061-US0

**Abandoned: January 4, 2003**

In re Patent Application of:  
Kazuhiro HARADA et al.

Customer No.: 07278

**Application No.: 09/718,659**

Confirmation No.: 2444

Filed: November 22, 2000

Art Unit: 1775

For: SILICON WAFER AND METHOD FOR  
MANUFACTURING THE SAME

Examiner: Stephen J. Stein

Attorney Docket No.: 21233/0211060-US0

**Abandoned: July 1, 2003**

**DECLARATION OF HIROYUKI TAKEUCHI**

Hon. Commissioner of Patents and Trademarks-  
Washington, D.C. 20231

I, **HIROYUKI TAKEUCHI**, hereby declare and state as follows:

I. **PERSONAL AND PROFESSIONAL BACKGROUND**

1. I am a citizen of Japan and am more than twenty-one (21) years of age;



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2. I am presently the General Manager of the Intellectual Property Department, Production & Technology Division, of SUMCO Corporation ("SUMCO IP Department"), Seavans North, 1-2-1 Shibaura, Minato-ku, Tokyo 105-8634, Japan (Phone: +81-3-5444-3958). My email address is hirotake@sumcosi.com;

3. I have held the position of General Manager of the SUMCO IP Department since April 2008. I have been employed by SUMCO Corporation ("SUMCO") (and its predecessor companies under the general family name of Mitsubishi Materials Silicon Corporation ("MSIL")), since about 1975. For sake of simplicity, I shall refer to SUMCO and its predecessor companies in the remainder of this Declaration generally and collectively as SUMCO;

4. SUMCO is a very large, multi-national company headquartered in Japan, with offices, factories, laboratories, and other facilities throughout Japan and around the world, that enables the company to operate through many subsidiary and other related companies. A major component of SUMCO's business involves wide and varied Intellectual Property ("IP") work and issues, including many patent and trademark matters that arise before the Japan Patent Office ("JPO") and other foreign patent offices around the world;

5. Accordingly, SUMCO has a large and varied cadre of IP professionals on which it relies, both within the company and outside. The SUMCO IP Department, of which I am the General Manager, manages and coordinates these activities in our Japan Headquarters for the entire company. At present, the SUMCO IP Department has about 16 full-time personnel in Japan, including Mr. Toshinobu Miura, Manager of the Department, and Mr. Hiroyuki Hasegawa, our Assistant Manager. In this manner, all IP issues of SUMCO are managed and coordinated from my Department in Japan wherever and

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1 however those issues may arise within the company, including its activities and interests in  
2 China, Europe, North America, and South America;

3 6. As a result of these broad and varied responsibilities, especially on the  
4 technical and scientific side, the SUMCO IP Department does business with many different  
5 and skilled patent attorneys and agents in Japan and elsewhere in support of these critically  
6 important company activities;

7 7. One of these outside patent attorneys in Japan is Mr. Masayoshi Suda;

### 8 II. THE SUDA PATENT OFFICE

9 8. For many years starting in the mid-1990's, SUMCO has had a continuous  
10 and very satisfactory business relationship with Mr. Suda, the founder of the Japanese  
11 Patent Law Firm known as the SUDA PATENT OFFICE ("SPO"), whose present address is  
12 Oak Ikebukuro Bldg 7F.21-11, Higashi-Ikebukuro 1-chome, Toshima-ku, Tokyo 170-0013  
13 Japan;

14 9. During these many years, SUMCO has entrusted Mr. Suda and SPO with  
15 significant IP work, including many patent and trademark matters before the JPO and other  
16 foreign patent offices around the world. For this latter work, which has grown considerably  
17 over time, SUMCO has generally relied upon Mr. Suda to recommend for SUMCO's  
18 approval foreign patent attorneys to work with SPO on behalf of SUMCO in IP matters within  
19 their individual countries;

20 10. As one example, SUMCO approved long ago to have a Mr. Jules Goldberg, a  
21 patent attorney in the U.S., represent SUMCO in IP matters concerning the U.S. through  
22 SPO and Mr. Suda. As part of this relationship, SUMCO has had the opportunity to meet

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1 three times over the years with Mr. Goldberg as his general travels have brought him to  
2 Japan to visit with SUMCO and his other Asian-based clients;

3 11. Among the matters entrusted over the years to Mr. Goldberg through SPO for  
4 SUMCO IP work was the preparation, filing, and prosecution of two specific U.S. patent  
5 applications, U.S. Application Serial No. 09/904,425 ("the '425 application"), filed on July 12,  
6 2001 for inventors Cindy Kohanek and Gary Babb, entitled "Linearity Measuring Apparatus  
7 for Wafer Orientation Flat," and Application Serial No. 09/718,659 ("the '659 application"),  
8 filed on November 22, 2000 for inventors Kazuhiro Harada, Hisashi Furuya, Jun Furukawa,  
9 Ken Nakajima, Hiroyuki Shiraki, and Yukio Muroi, entitled "Silicon Water and Method for  
10 Manufacturing the Same;"

11 12. The present assignees of the '425 application are SUMCO Corporation and  
12 the SUMCO PHOENIX Corporation ("SPX"), a SUMCO subsidiary located in the U.S.  
13 SUMCO Corporation is the sole assignee of the '659 application. Ultimate responsibility for  
14 the prosecution of these two U.S. patent applications, despite the joint ownership of SPX in  
15 the '425 application, was and remains with the SUMCO IP Department in Japan of which I  
16 am the General Manager;

17 13. Both the '425 application and the '659 application were filed in the U.S. PTO  
18 by Mr. Goldberg through the auspices of SPO;

19 14. As I stated previously, the relationship between SUMCO and Mr. Suda has  
20 been an extremely satisfactory one that has resulted, in large part, by the personal and  
21 reliable way Mr. Suda has conducted business with SUMCO. Mr. Suda has made a point  
22 over the years to visit SUMCO's Japanese Institutes and factories several times each year,  
23 and more, to interview and meet SUMCO inventors and staff members of the SUMCO IP

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1 Department. These inventor interviews have been usually directed to invention proposals  
2 and memoranda about the proposals for the potential filing of Japanese patent applications  
3 in the JPO. If these proposals are worthy of filing in the eyes of SUMCO, detailed examples  
4 and comparative example data from the inventors are eventually gathered by Mr. Suda, and  
5 his SPO assistants, to help prepare specifications and drawings for the Japanese  
6 applications, which are then reviewed and approved by the SUMCO inventors and the  
7 SUMCO IP Department;

8 15. It has been the experience of SUMCO, with its extensive dealing with Mr.  
9 Suda and SPO, that whenever JPO office actions are received by SPO in SUMCO patent  
10 applications, SPO prepares and forwards to the SUMCO IP Department detailed comments  
11 about those office actions, usually within about two weeks of their receipt, along with  
12 proposed claims / amendments, if necessary. In this manner, the SUMCO IP Department  
13 understands that SPO has tried to set a deadline for receipt of the SUMCO reply to its  
14 comments and, in those few instances where the SUMCO IP Department does not timely  
15 send those replies, SPO sends a reminder to SUMCO until the comments are received;

16 16. With regard to foreign office actions (including those from the U.S. PTO), the  
17 SUMCO IP Department has observed that SPO usually translates into English our  
18 Department's Japanese comments to SPO on those actions, and then prepares and sends  
19 those English instructions to the foreign patent attorneys in light of those comments --  
20 usually two weeks before the actual due date of a response to the office action;

21 17. In the general timeframe of 1994 through 2003, SPO corresponded with the  
22 SUMCO IP Department mostly by facsimile and mail, and partially by e-mail, in the following  
23 manner:

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1 a. SPO drafted documents to be filed with the JPO or foreign patent  
2 offices were sent to the SUMCO IP Department by facsimile in accordance  
3 with the applicable due dates;

4  
5 b. the SUMCO-corrected draft documents were returned to SPO by  
6 facsimile;

7  
8 c. SPO-revised draft documents were sent to the SUMCO IP  
9 Department by facsimile within a couple of days of receipt of the SUMCO  
10 corrections;

11  
12 d. SUMCO's instructions for filing of the final documents with the JPO or  
13 foreign patent offices were sent to SPO by facsimile or e-mail by the  
14 deadline set by SPO; and

15  
16 e. the filed documents were sent to the SUMCO IP Department by mail  
17 within a couple of days after their actual filing;

18  
19 18. In the general time period of later 2003 through early 2007, SPO  
20 corresponded with the SUMCO IP Department mostly by e-mail and regular mail, and  
21 partially by facsimile, in the same manner as described in the preceding paragraph of this  
22 Declaration, except that email was generally used other than facsimile (or both methods  
23 were used), but for subparagraph (e) where mail was still generally used;

24 19. In the general time period of early 2007 through the end of 2008, SPO  
25 corresponded with the SUMCO IP Department mostly by Virtual Private Network (VPN) and  
26 e-mail, and partially by regular mail, in the general manner as described previously;

27 20. Although personnel at both SPO and the SUMCO IP Department have  
28 changed over the years, in the general time period of 1994 through most of 2002, Mr.  
29 Hayashi, Mr. Masuda, and Ms. Nagao were the main personnel from SUMCO'S IP  
30 Department communicating with Mr. Suda and Ms. Yamada of SPO. After this general time  
31 period through most of 2003, Mr. Masuda, Mr. Sudo (a different person than SPO's Mr.  
32 Suda who just happens to have a similar family name), Ms. Nagao, and Ms. Kon were the

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1 main people from my Department communicating with Mr. Suda, and Ms. Yamada from  
2 SPO. After this time period through early 2008, mainly Mr. Sudo and Ms. Kon from SUMCO  
3 were communicating with SPO's Mr. Suda, Ms. Yamada, and Mr. Fusejima. And, finally  
4 from this last period through 2008, it was Mr. Hasegawa and Ms. Kon from the SUMCO IP  
5 Department with SPO's Mr. Suda, Mr. Fusejima, and Ms. Imai;

6 21. With particular regard to both the '425 and '659 applications, most of the main  
7 direct communications concerning these applications were conducted by and through  
8 SUMCO's Mr. Hayashi and Mr. Masuda, and SPO's Mr. Suda;

9 22. For example with respect to the '425 application, in the time period following  
10 the Non-Final Office Action mailed from the U.S. PTO on July 3, 2002, there were at least  
11 seven back-and-forth communications between SPO and the SUMCO IP Department;

12 23. For example with respect to the '659 application, in the time period following  
13 the Final Office Action mailed from the U.S. PTO on December 31, 2002 through and after  
14 the Proposed Amendment of June 20, 2003 was filed in the U.S. PTO in response to the  
15 Advisory Action of May 20, 2003, there were at least eight back-and-forth communications  
16 between SPO and the SUMCO IP Department;

17 **V. DISCOVERY OF THE ABANDONMENTS**

18 24. On or about November 27, 2008, Mr. Suda made an appointment for  
19 December 1, 2008 to meet with the SUMCO IP Department to discuss Mr. Goldberg's recent  
20 performance and reliability, especially in light of the latest notice received by Mr. Suda from  
21 Mr. Goldberg that Mr. Goldberg would be departing his third U.S. law firm within a three-year  
22 period at the end of 2008 and, as a result, Mr. Goldberg had asked that for SPO clients,

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1 including SUMCO, who had pending U.S. patent applications with Mr. Goldberg, those  
2 applications be transferred to Mr. Goldberg's care at his new law firm;

3 25. The SUMCO IP Department met with Mr. Suda on December 1<sup>st</sup> and, at that  
4 meeting, decided to consider a U.S. law firm other than Mr. Goldberg's then present law firm  
5 for the SUMCO work previously entrusted to Mr. Goldberg;

6 26. Mr. Suda again returned to the SUMCO IP Department on December 12,  
7 2008, when he visited with me, Mr. Miura (the Manager of the Department), and Mr.  
8 Hasegawa (our Assistant Manager). During this meeting, Mr. Suda reported to all three of  
9 us with the greatest and most sincerest of apologies that Mr. Suda was informed by Mr.  
10 Goldberg, for the first time, that both the '425 and '659 patent applications had become  
11 abandoned. SUMCO was very upset with this information as the SUMCO IP Department  
12 had no previous knowledge whatsoever of the abandonments. I made clear to Mr. Suda at  
13 that moment that he should make his strongest efforts to have both patent applications  
14 revived by the U.S. PTO, which were not abandoned intentionally or knowingly by the  
15 SUMCO IP Department, or by myself, Mr. Muira, or Mr. Hasegawa;

16 27. Upon looking into this matter further from SUMCO's perspective, I was not  
17 able to determine why the SUMCO IP Department did not contact SPO at any time about  
18 the '425 or '659 applications after the last communications the SUMCO IP Department  
19 received from SPO concerning the applications, as mentioned in paragraphs 22 and 23 of  
20 this Declaration, until the December 12, 2008 date when Mr. Suda notified the SUMCO  
21 Patent Department of the abandonments. I can state only the fact that no such contact in  
22 this regard was made during this extended time period and that, in all likelihood, the reason  
23 for this lack of contact was that the SUMCO IP Department relied upon its many years of

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1 experience and confidence with SPO and Mr. Suda to be contacted in a timely fashion about  
2 matters of importance concerning the SUMCO IP work entrusted to Mr. Suda and SPO;

3 28. Nonetheless, I can state unequivocally and without any reservation  
4 whatsoever that, during the entire time both of the '425 and the '659 applications were  
5 believed by the SUMCO IP Department to be pending before the U.S. PTO, including the  
6 time period from the last communications the SUMCO IP Department received from SPO  
7 concerning the applications, as mentioned in paragraphs 22 and 23 of this Declaration; until  
8 the December 12, 2008 date when Mr. Suda notified our Department of the abandonments,  
9 the SUMCO IP Department did not intend either application to go abandoned, nor did the  
10 SUMCO IP Department have knowledge or reason to believe either application had gone  
11 abandoned;

### 12 VII. CONCLUSION

13 29. In signing this Declaration, I understand that the Declaration will be filed as  
14 evidence in support of a Petition to Revive for the '425 and '659 applications; and

15 30. I declare that all statements made herein of my own knowledge are true, and  
16 that all statements made on information and belief are believed to be true. I further declare  
17 that these statements were made with the knowledge and understanding that willful false  
18 statements and the like so made are punishable by fine, or imprisonment or both, under  
19 Section 1001 of Title 18 of the United States Code, and that such willful false statements  
20 may jeopardize the validity of any U.S. patents issued from such applications.

21



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Respectfully submitted,

Dated: Jan. 29, 2009

HiroYuki Takeuchi  
HIROYUKI TAKEUCHI